

### **REMARKS/ARGUMENTS**

Prior to entry of this amendment, claims 1-86 were pending in this application. Claims 1, 2, 13, 14, 25, 28, 40, 45, 57, 62, and 74 have been amended, no claims have been added, and claim 79 has been canceled herein. Therefore, claims 1-78 and 80-86 remain pending. Applicant respectfully requests reconsideration of these claims for at least the reasons presented below.

#### **Double Patenting Rejection**

The Office Action has rejected claims 1 and 13 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,331,514 to Sellen et al. The Applicants submit herewith an appropriate Terminal Disclaimer rendering the rejection moot. Therefore, the Applicants respectfully request withdrawal of the rejection.

#### **35 U.S.C. § 102 Rejection, Koakutsu**

The Office Action rejected claims 25-28, 35-37, 39-45, 52-54, 56-62, 69-71, 73-80, and 85-86 under 35 U.S.C. § 102(e) as being anticipated by U. S. Patent No. 6,902,105 to Koakutsu (hereinafter "Koakutsu"). The Applicant respectfully submits the following arguments pointing out significant differences between claims 25-28, 35-37, 39-45, 52-54, 56-62, 69-71, 73-80, and 85-86 submitted by the Applicants and Koakutsu.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully argue that Koakutsu fails to disclose each and every claimed element. For example, Koakutsu fails to disclose, either expressly or inherently,

determining whether the merchant is allowed to process corporate transactions, i.e., corporate checks.

Koakutsu is directed to "capturing image data from negotiable instruments such as checks used for settling transactions." (Col. 1, lines 10-11) More specifically, Koakutsu is directed to "a negotiable instrument processing apparatus, method, and system for minimizing the data size of the image data captured from a check or other negotiable instrument during electronic payment processes." (Col. 1, lines 49-53) Under Koakutsu "the reading process time and data size of the resulting image data can both be reduced by thus capturing image data from the negotiable instrument by scanning only a defined reading area." (Col. 1, lines 63-67) However, Koakutsu does not disclose, expressly or inherently, determining whether the merchant is allowed to process corporate transactions, i.e., corporate checks. Rather, Koakutsu notes that business checks and personal checks are different sizes and describes setting the reading area for the check accordingly. (See col. 12, lines 14-38)

Claim 25, upon which claims 26-39 depend, recites in part "determining whether the information about the check transaction includes an indicator that indicates that the check transaction involves a corporate check; determining whether the subscribing merchant is allowed to process corporate checks; and in response to determining the subscribing merchant is allowed to process corporate checks, determining whether to authorize or decline the check transaction as a corporate check transaction based on the presence of the indicator and the information about the check transaction." Koakutsu does not disclose, expressly or inherently, determining whether the subscribing merchant is allowed to process corporate checks and in response to determining the subscribing merchant is allowed to process corporate checks, determining whether to authorize or decline the check transaction as a corporate check transaction based on the presence of the indicator and the information about the check transaction. Rather, Koakutsu notes that business checks and personal checks are different sizes and describes setting the reading area for the check accordingly. For at least these reasons, the Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Claim 40, upon which claims 41-56 depend, recites in part "determining whether the merchant is allowed to conduct corporate type transactions; and in response to determining the merchant is allowed to conduct corporate type transactions, determining whether to authorize the financial transaction as a corporate type transaction based at least on whether the information includes an indicator that indicates that the financial transaction is a corporate type transaction." Koakutsu does not disclose, expressly or inherently, determining whether the merchant is allowed to conduct corporate type transactions and in response to determining the merchant is allowed to conduct corporate type transactions, determining whether to authorize the financial transaction as a corporate type transaction based at least on whether the information includes an indicator that indicates that the financial transaction is a corporate type transaction. Rather, Koakutsu notes that business checks and personal checks are different sizes and describes setting the reading area for the check accordingly. For at least these reasons, the Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Claim 57, upon which claims 58-73 depend, recites in part "a processor that determines whether the merchant is allowed to conduct corporate type transactions and determines whether to authorize the financial transaction as a corporate type transaction based at least on whether the information includes an indicator that indicates that the financial transaction is a corporate type transaction." Koakutsu does not disclose, expressly or inherently, determining whether the merchant is allowed to conduct corporate type transactions and determining whether to authorize the financial transaction as a corporate type transaction based at least on whether the information includes an indicator that indicates that the financial transaction is a corporate type transaction." Rather, Koakutsu notes that business checks and personal checks are different sizes and describes setting the reading area for the check accordingly. For at least these reasons, the Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Claim 74, upon which claims 75-78 and 80-86 depend, recites in part "a second means for determining whether the merchant is allowed to conduct corporate type transactions

and, in response to determining the merchant is allowed to conduct corporate type transactions, authorizing the financial transaction as a corporate type transaction based at least on the information about the financial transaction." Koakutsu does not disclose, expressly or inherently, determining whether the merchant is allowed to conduct corporate type transactions and, in response to determining the merchant is allowed to conduct corporate type transactions, authorizing the financial transaction as a corporate type transaction based at least on the information about the financial transaction. Rather, Koakutsu notes that business checks and personal checks are different sizes and describes setting the reading area for the check accordingly. For at least these reasons, the Applicants respectfully request withdrawal of the rejection and allowance of the claims.

**35 U.S.C. § 103 Rejection, Koakutsu in view of Templeton**

Claims 1-3, 5-15, 17-24, 29, 31-34, 38, 46, 48-51, 55, 63, 65-68, 72, and 82-84 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Koakutsu in view of U.S. Patent No. 5,679,940 to Templeton et al. (hereinafter "Templeton"). The Applicants respectfully submit that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims, as amended. Therefore, the Applicants request reconsideration and withdrawal of the rejection.

In order to establish a *prima facie* case of obviousness, the Office Action must establish: 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine their teachings; 2) a reasonable expectation of success of such a modification or combination; and 3) a teaching or suggestion in the cited prior art of each claimed limitation. See MPEP §706.02(j). As will be discussed below, the references cited by the Office Action do not teach or suggest each claimed limitation. For example, none of the references, alone or in combination, teach or suggest determining whether the merchant is allowed to process corporate transactions, i.e., corporate checks.

As discussed in detail above, Koakutsu does not teach or suggest determining whether the merchant is allowed to process corporate transactions, i.e., corporate checks. Rather, Koakutsu notes that business checks and personal checks are different sizes and describes setting the reading area for the check accordingly.

Templeton is directed to "methods and systems for interactive check authorizations using an electronic transaction terminal for acquiring transaction data at the point of sale." (Col. 1, lines 10-13) However, Templeton also does not teach or suggest, alone or in combination with Koakutsu, determining whether the merchant is allowed to process corporate transactions, i.e., corporate checks. Rather, Templeton is silent with regard to corporate checks or transactions.

Claim 1, upon which claims 2-12 depend, recites in part determining whether the electronic information about the check includes an indicator that indicates the presence of an auxiliary on-us field on a magnetic ink character recognition (MICR) associated with the check wherein the presence of the auxiliary on-us field denotes that the check is a corporate check; in response to determining the check includes the indicator, determining whether the subscribing merchant is allowed to process corporate checks electronically; and in response to determining the merchant is allowed to process corporate checks electronically, performing a risk assessment for the corporate check based at least in part on the electronic information to thereby authorize or decline the corporate check." Neither reference, alone or in combination, teaches or suggests determining whether the subscribing merchant is allowed to process corporate checks electronically and in response to determining the merchant is allowed to process corporate checks electronically, performing a risk assessment for the corporate check based at least in part on the electronic information to thereby authorize or decline the corporate check. Rather, Koakutsu notes that business checks and personal checks are different sizes and describes setting the reading area for the check accordingly while Templeton is silent with regard to corporate checks or transactions. For at least these reasons, the Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Claim 13, upon which claims 14-24 depend, recites in part a processor that determines whether the electronic information about the check includes an indicator that indicates the presence of an auxiliary on-us field on a magnetic ink character recognition (MICR) associated with the check wherein the presence of the auxiliary on-us field denotes that the check is a corporate check; a merchant database that facilitates determination of whether the subscribing merchant is allowed to process corporate checks electronically; and a risk assessment component that assesses risk associated with the corporate check based at least in part on the electronic information to thereby authorize or decline the corporate check if the subscribing merchant is allowed to process corporate checks electronically." Neither reference, alone or in combination, teaches or suggests a merchant database that facilitates determination of whether the subscribing merchant is allowed to process corporate checks electronically; and a risk assessment component that assesses risk associated with the corporate check based at least in part on the electronic information to thereby authorize or decline the corporate check if the subscribing merchant is allowed to process corporate checks electronically. Rather, Koakutsu notes that business checks and personal checks are different sizes and describes setting the reading area for the check accordingly while Templeton is silent with regard to corporate checks or transactions. For at least these reasons, the Applicants respectfully request withdrawal of the rejection and allowance of the claims.

**35 U.S.C. § 103 Rejection, Koakutsu and Templeton, in view of Repak**

Claims 4 and 16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Koakutsu, as modified by Templeton as applied to claims 1 and 13 above, and further in view of U.S. Patent Publication No. 2003/0229586 of Repak (hereinafter "Repak"). Applicants respectfully request withdrawal of the rejection and allowance of the claims for at least the reason that claims 4 and 16 each depend upon a base claim that is thought to be allowable as discussed in detail above.

**35 U.S.C. § 103 Rejection, Koakutsu in view of Repak**

Claims 30, 47, 64, and 81 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Koakutsu in view of Repak. Applicants respectfully request withdrawal of the rejection and allowance of the claims for at least the reason that claims 30, 47, 64, and 81 each depend upon a base claim that is thought to be allowable as discussed in detail above.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

/William J. Daley/  
William J. Daley  
Reg. No. 52,471

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 303-571-4000  
Fax: 415-576-0300

WJD:jep  
61429479 v1